Attorney Docket No. LOT920030069US1 (7321-023U) **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46321
Joseph A. RUSSO, et al.	:	Confirmation Number: 5725
Application No.: 10/737,131	:	Group Art Unit: 2154
Filed: December 15, 2003	:	Examiner: Wen-Tai Lin

For: COMMUNITY ENROLLMENT MODELING

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated February 1, 2010.

The Examiner's response to Appellants' arguments submitted in the Second Appeal Brief of October 14, 2009, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Second Appeal Brief and the arguments set forth below.

REMARKS

Appellants have compared the statement of the rejection found on pages 3-6 of the Examiner's Answer with the statement of the rejection found on pages 5-10 of the Forth Office Action. Upon making this comparison, Appellants have been unable to discover any substantial differences between the respective statements of the rejection. As such, Appellants proceed on the basis that the Examiner's sole response to Appellants' Appeal Brief is found on pages 6-8 of the Examiner's Answer in the section entitled "Response to Argument."

Rejection under 35 U.S.C. § 102

On page 9, line 2 through page 12, line 10 of the Second Appeal Brief, Appellants presented certain arguments with regard to the claimed "collaborative computing community" and the proper construction of this term. The Examiner's response to these arguments is found in Paragraph "10" on page 7 of the Examiner's Answer, which is reproduced below:

> Initially, the examiner would like to point out that paragraph 0003 of Applicant's specification does not constitute a precise definition for the phrase "collaborative computing community." The examiner consistently stated in the previous office actions that paragraph 0003 only describes a possible definition for the "collaborative computing community." Since this paragraph does not contain an exclusive definition for the phrase, the four itemized limitations in the paragraph are not read into the claims. That is, the claims are interpreted in light of the specification, but limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993). (emphasis original).

The flaw in the Examiner's analysis is evident by how the Examiner mischaracterized the specification of the invention. In particular, the Examiner in all the prior office actions has failed to provide any claim construction regarding the term "collaborative computing community". Despite the lack of analysis on the part of the Examiner, the Appellants have consistently presented the position that the term "collaborative computing community" must be construed

consistent to what one of ordinary skill in the art would understand the term "collaborative computing community" to be with respect to the specification. As such, the Appellants continuously presented the position that:

In particular, the Applicants have defined the "collaborative computing community" as being "defined by (1) a particular context, i.e., the objective of the environment, (2) membership, i.e., the participants in the environment, (3) a set of roles for the members, and (4) resources and tools which can be accessed by the membership in furtherance of the objective of the environment" (See paragraph [0003] of Applicants' application). Clearly, Olivier cannot teach each and every limitation recited in claim 1 as the term "collaborative computing community" is wholly absent from Olivier. Thus, it is impossible for Olivier to anticipate claim 1 under 35 U.S.C. § 102(b) and Applicants respectfully request withdrawal of the rejections of claims 1-9 and 11 under 35 U.S.C. § 102(b).

Up and until the Examiner's Answer, the Examiner has ignored Appellant's request that the term "collaborative computing community" be construed as being "defined by (1) a particular context, i.e., the objective of the environment, (2) membership, i.e., the participants in the environment, (3) a set of roles for the members, and (4) resources and tools which can be accessed by the membership in furtherance of the objective of the environment" (See paragraph [0003] of Applicants' specification) with respect to the specification of the 10/737,121 application. Instead the Examiner has merely stated that the term "collaborative computing community" "is a possible definition for the "collaborative computing community." and that since this paragraph does not contain an exclusive definition for the phrase, the four itemized limitations in the paragraph are not read into the claims." The Examiner's analysis is legally incorrect. In fact, the Federal Circuit has held that were there is only a single definition in the specification, as there is

in the present case, the limitations associated with that particular elements do become part and partial of the overall claim. See Biogen, Inc. v. Berlex Labs., Inc., 318 F.3d 1132, 1139-40 (Fed. Cir. 2003) (limiting both method and apparatus claims "to conform with the basis on which the invention was presented in the specification").

Accordingly, the Appellants claim construction and not the Examiner's claim construction can properly construe the term "computing community" as recited in the claims of the current application.

For the reasons set forth in the Appeal Brief of October 14, 2009, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 102.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 122158, and please credit any excess fees to such deposit account.

Date: April 1, 2010

Respectfully submitted,

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